

REMARKS

Claims 1, 26-27, 32-41, 45-46, 59, 67, 80, 91-92, 94-98, 101, 103-113, 115, 120, 122-127, 131, 155-156, and 158-160 are pending in this application.

I. Restriction Requirement and Election of Species Requirements

The Office has required election of one of five groups, as well as a provisional election of a species:

Group I (claims 1, 26-27, 32-41, 45-46, 59, 67, and 80), drawn to a method preparing compounds of Formula (I).

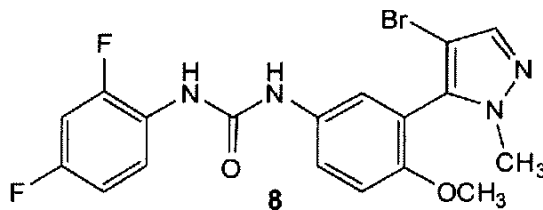
Group II (claims 91-92, 94-98, 101, 103-113, 115, and 160), drawn to a method preparing compounds of Formula (II), (IV), and (V).

Group III (claims 120 and 122-127), drawn to a method preparing compounds of Formula (VI).

Group IV (claims 131, 155-156, and 158), drawn to compounds of Formula (II), (IV), and (V).

Group V (claims 131 and 159), drawn to compounds of Formula (VI).

Applicants hereby elect Group I (claims 1, 26-27, 32-41, 45-46, 59, 67, and 80) with traverse. Applicants further elect the species of Example 5 (compound 8), *N*-(2,4-difluorophenyl)-*N'*-(4-methoxy-3-(4'-bromo-1'-methyl-1H-pyrazol-5'-yl)phenyl)urea, at page 48, lines 5-8 of the specification (structure shown below) with traverse. Compound 8 corresponds to a compound of Formula (I), wherein R² is methyl, R³ is Br, R⁴ is methoxy, R⁵ is H, R^{1a} is fluoro, R^{1c} is fluoro, R^{1b} is H, R^{1d} is H, and R^{1e} is H. Claims 1, 26, 32-41, 45-46, 59, 67, and 80 read on compound 8.



Applicants respectfully request rejoinder of Groups I, II, and IV as a single group and separate rejoinder of Groups III and V as a single group. As will be appreciated, “unity of

invention (not restriction) practice is applicable in ... national stage applications submitted under 35 U.S.C. 371." M.P.E.P. § 1893.03(d). Unity of invention must be determined under the provisions of the PCT in a national stage application filed under 35 U.S.C. § 371. *Caterpillar Tractor Co. v. Com'r Pat. & Trademarks*, 650 F. Supp. 218 (E.D. Va. 1986). The legal standard for determining unity of invention is set forth in Rule 13, which states, in part:

the requirement of unity of invention ... shall be fulfilled ... when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

P.C.T. Rule 13.2; M.P.E.P. § 1850. The presence of a special technical feature linking the claims thus defines the unity of invention standard.

In the case of intermediates and final products from different processes, the 10.18 of the Guidelines provides that different intermediate products and final products may be presented in the same application if they share an essential structural element:

- (b) Unity of invention is considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:
 - (A) the intermediate and final products have the same essential structural element, in that:
 - (1) the basic chemical structures of the intermediate and the final products are the same, or
 - (2) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and
 - (B) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element
- (d) It is possible in a single international application to accept different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

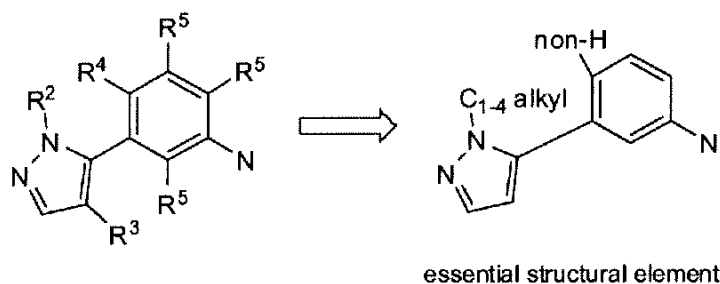
Further, Example 6 in 10.26 of the Guidelines makes it clear that an apparatus or product claim and multiple process claims can be presented in a single application without destroying

unity of invention if they have a special technical feature in common (see attached copy of 10.26 of the Guidelines, showing that claims to a fuel burner and two separate processes shared unity of invention due to the presence of a “tangential fuel inlet” in each of the claims).

A. Rejoinder of Groups I, II, and IV

As a preliminary matter, the Office has provided no reason for why the compounds of Formulas (I), (II), (IV), and (V) lack an essential structural element. Instead, the Office merely states that the compounds of Formula (I) and (VI) differ from each other due to the absence of a “1,2-diazole ring” in the compounds of Formula (VI).¹ However, no reason is given for why the compounds of Formulas (I), (II), (IV), and (V) lack an essential structural element.

Applicants respectfully assert that the compounds of Formulas (I), (II), (IV), and (V) share the following essential structural element, wherein R² is C₁₋₄ alkyl and R⁴ is a non-hydrogen substituent (see below). Hence, the processes of preparing the compounds of Formula (I) (Group I), the process of preparing the compounds of Formulas (II), (IV), and (V) (Group II), and the compounds of Formulas (II), (IV), and (V) (Group IV) have a special technical feature and, therefore, share unity of invention with each other. Accordingly, Groups I, II, and IV should be rejoined.



¹ Presumably, the term “1,2-diazole ring” refers to the pyrazole ring in Formula (I).

B. Rejoinder of Groups III and V

As will be appreciated, a product and a process specially adapted for the manufacture of the product can be presented in one application without destroying unity of invention. In particular, M.P.E.P. § 1850 provides that:

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an **independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product...**

...a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

The process of Group III inherently produces the compound of Formula (VI) in Group V. Hence, the process of Group III is specially adapted for the manufacture of the product in Group V. For this reason, Groups III and V should be separately rejoined as a single group.

C. Provisional Election of Species

M.P.E.P. § 803.02 provides that:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

For the reasons summarized above, the compounds of Groups I, II, and IV share unity of invention as they share a special technical feature (the essential structural element shown above).

Applicants, therefore, respectfully request that the provisional election of species requirement be withdrawn.

II. Other Applications

The following applications are co-owned. The Examiner is urged to review the files of those applications to determine whether any of the information contained therein has any pertinence to examination of the present application.

11/883,043, US 2008/0194836, copending

10/895,789, US 2005/0080124, copending

11/603,601, US 2007/0072857, now abandoned

11/603,626, US 2007/0078134, now abandoned

09/929,071, US 6,107,324, issued

Below are status updates with respect to those of the above-listed applications, which have not yet issued. These summaries are not intended to be comprehensive.

In Ser. No. 11/833,043, a restriction requirement was mailed on May 12, 2009. A reference was made to WO 02/076464.

In Ser. No. 10/895,789, a restriction requirement was mailed on March 9, 2007 and a response thereto was filed on June 8, 2007. On September 4, 2007, a non-final rejection was mailed, containing rejections under § 103 over WO 99/52927 in view of Topliss, *J. Med. Chem.* 20(4):463-469 (1977) and an obviousness-type double patenting rejection over 11/603,601. A final rejection mailed February 8, 2008 further cited WO 02/076464 as support for the § 103 rejection. The ODP and § 103 rejections were overcome during prosecution.

On July 7, 2008, a non-final rejection was mailed, asserting a new § 103 rejection over Teegarden, CAPLUS abstract for WO 03/062206 in view of Burger, *Prog. Drug Res.* 37:287-371 (1991). A response was filed thereto on October 3, 2008. A final rejection was mailed on January 7, 2009, maintaining the § 103 rejection. A RCE was filed on April 6, 2009. The case remains pending.

In Ser. No. 11/603,601, a restriction requirement was mailed on March 12, 2007 with a response thereto filed on June 11, 2007. On September 4, 2007, a non-final rejection was

mailed, containing an ODP rejection over 11/603,626 and a § 103 rejection over WO99/52927 in view of Topliss, *J. Med. Chem.* 20(4):463-469 (1977). On February 12, 2008, a final rejection was mailed which further cited WO 02/076464 as support for the § 103 rejection. The ODP and § 103 rejections were overcome during prosecution.

On July 11, 2008, a non-final rejection was mailed, asserting a new § 103 rejection over Teegarden, CAPLUS abstract for WO 03/062206 in view of Burger, *Prog. Drug Res.* 37:287-371 (1991). A response was filed thereto on October 3, 2008. A final rejection was mailed on January 12, 2009, maintaining the § 103 rejection. An RCE was filed on April 6, 2009. A request for express abandonment was filed on April 7, 2009, and a notice of abandonment was mailed on April 24, 2009.

In Ser. No. 11/603,626, a request for express abandonment was filed on August 10, 2007, and a notice of abandonment was mailed on November 16, 2007.

III. Conclusion

Applicants respectfully request rejoinder of Groups I, II, and IV as a single group, rejoinder of Groups III and V as a single group, and withdrawal of the election of species requirement. Further, early reconsideration and allowance of all pending claims is respectfully requested.

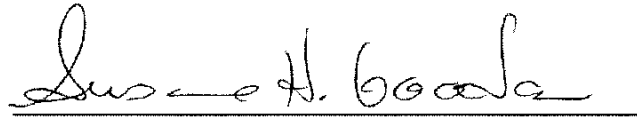
The Commissioner is hereby authorized to debit any fee due or credit any overpayment to Deposit Account No. 06-1050. Further, if not accompanied by an independent petition, this paper constitutes a Petition for an Extension of Time for an amount of time sufficient to extend the deadline and authorizes the Commissioner to debit the petition fee and any other fees or credits to Deposit Account No. 06-1050.

Applicant : John Robert Fritch, et al.
Serial No. : 10/593,847
Filed : August 2, 2007
Page : 8 of 8

Attorney's Docket No.: 20750-
0050US1 / 083.US2.PCT

Respectfully submitted,

Date: May 29, 2009



Susanne H. Goodson, Ph.D.
Reg. No. 58,450

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022
Telephone: (302) 652-5070
Facsimile: (877) 769-7945

Enclosure: 10.26 of the Guidelines

80079266

compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A. However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

10.24 Example 4

Claim 1: Use of a family of compounds X as insecticides.

Claim 2: Compound X₁ belonging to family X.

Provided X₁ has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

10.25 Example 5

Claim 1: A process for treating textiles comprising spraying the material with a particular coating composition under special conditions (for example, as to temperature, irradiation).

Claim 2: A textile material coated according to the process of claim 1.

Claim 3: A spraying machine for use in the process of claim 1 and characterized by a new nozzle arrangement providing a better distribution of the composition being sprayed.

The process according to claim 1 imparts unexpected properties to the product of claim 2. The special technical feature in claim 1 is the use of special process conditions corresponding to what is made necessary by the choice of the particular coating. Unity exists between claims 1 and 2. The spraying machine in claim 3 does not correspond to the above identified special technical feature. Unity does not exist between claim 3 and claims 1 and 2.

10.26 Example 6

Claim 1: A fuel burner with tangential fuel inlets into a mixing chamber.

Claim 2: A process for making a fuel burner including the step of forming tangential fuel inlets into a mixing chamber.

Claim 3: A process for making a fuel burner including casting step A.

Claim 4: An apparatus for carrying out a process for making a fuel burner including feature X resulting in the formation of tangential fuel inlets.

Claim 5: An apparatus for carrying out a process for making a fuel burner including a protective housing B.

Claim 6: A process of manufacturing carbon black including the step of tangentially introducing fuel into a mixing chamber of a fuel burner.

Unity exists between claims 1, 2, 4, and 6. The special technical feature common to all the claims is the tangential fuel inlets. Claims 3 and 5 lack unity with claims 1, 2, 4, and 6 since claims 3 and 5 do not include the same or corresponding special technical feature as set forth in claims 1, 2, 4, and 6. Claims 3 and 5 would also lack unity with one another.